

REMARKS:

Claims 36-51 are presented for examination, with claims 1-35 having been cancelled hereby.

In the Office Action, the Examiner has rejected claims 1-10, 12-25 and 27-35 under 35 U.S.C. §102(b) as allegedly being unpatentable over U.S. Patent Application Publication 2002/0065896 hereinafter “Burakoff” The Examiner has also rejected claims 1-10, 12-25 and 27-35 under 35 U.S.C. §103(a) as allegedly being unpatentable over Burakoff in view of U.S. Patent No. 6,122,635, hereinafter “Burakoff ‘635.” The Examiner has also rejected claims 3, 4, 20 and 21 under 35 U.S.C. §103(a) as allegedly being unpatentable over Burakoff in view of Burakoff ‘635 and further in view of Bosarge and US Patent Application Publication 2003/0191683 hereinafter “Bosarge” Lastly, the Examiner has rejected claims 13-16, 19 and 32 under 35 U.S.C. §103(a) as allegedly being unpatentable over Burakoff in view of Burakoff ‘635 and further in view of website www.tdcanadatrust.com hereinafter “TD Canada Trust” as evidence by TD Mutual Funds Centre, Ref. U, hereinafter “Ref. U,” TD Mutual Fund Profiles, Ref. V, hereinafter “Ref. V,” TD Mutual Funds Simplified Prospectus, Ref. W, hereinafter “Ref. W” and TD Mutual Funds Disclosure, Ref. X, hereinafter “Ref. X.” Office action at 4,9 and 11.

Because each of claims 1-35 has been cancelled, it is respectfully submitted that the specific rejections made in the Office Action have been rendered moot. However, since new claims 36-51 essentially correspond to now-cancelled claims 1-10, 12-25 and 27-35, a few remarks highlighting some of the distinctions between the invention currently claimed and the Burakoff, Burakoff ‘635, Bosarge et al., TD Canada Trust as evidenced by Ref. U, Ref. V, Ref. W and Ref. X references will be made.

35 U.S.C §102(b) Rejection based on Burakoff

The Examiner has rejected claims 1-10, 12-25 and 27-35 under 35 U.S.C. §102(b) as allegedly being unpatentable over Burakoff. As detailed below, Burakoff does not disclose each and every claim limitation of the pending claims. In any case, because each of claims 1-35 has been cancelled, it is respectfully submitted that the specific rejections made in the Office Action have been rendered moot.

35 U.S.C §103(a) Rejection based on Burakoff in view of Burakoff '635

The Examiner has rejected claims 1-10, 12-25 and 27-35 under 35 U.S.C. §103(a) as allegedly being unpatentable over Burakoff in view of U.S. Patent No. 6,122,635, hereinafter "Burakoff '635. Because each of claims 1-35 has been cancelled, it is respectfully submitted that the specific rejections made in the Office Action have been rendered moot. Nonetheless, out of an abundance of completeness, the Examiner's position with relative to this rejection is addressed below in view of new claims.

Importantly, the Examiner has acknowledged that "Burakoff does not explicitly teach investor documents comprising a plurality of parts with each of the plurality of parts defined with a trade identifier and determining required investment information for the investor by the use of trade identifiers." Office action at 5.

Thus, in addition to the above deficiencies noted by the Examiner, as detailed below, Burakoff does not disclose the following limitations of new claims. Specifically, the Examiner cites paragraphs 29, 43 and 49 of Burakoff, as disclosing "the history source comprising history data representative of at least one past transaction for at least one investor." In actuality, paragraph 29 of Burakoff discloses:

[0029] The computer communications link 18 between the individual's computer 16 and the other computer 20 is depicted as a "cloud" in FIG. 1B to indicate that it may be any of a variety of mediums over which two computers may transfer data. In the example, the other computer 20 is a server that receives and logs the consent sent from the individual's computer 16. The other computer 20 may be maintained by, for example, the sender or originator of the information stored by the device 10 or the other computer 20 may be a system on which multiple sensitive information documents are stored along with records of individuals' consents. This logging computer 20 would then be a clearinghouse for information and consent storage. The originator of the information (e.g. a financial institution) may be different from the sender of the information (e.g. an information clearinghouse).

Paragraph 43 of Burakoff discloses:

[0043] The logging computer 20, may operate as a sensitive information and consent storing clearinghouse, storing records of consents provided by users 14. The record in the logging computer 20 includes an identifier of the accounts for which consent to receive electronic delivery of sensitive information has been granted. As has been described, it is possible that consent may have only been granted for certain types of information to be delivered electronically. All of this data, however, may be maintained in the logging computer 20.

Thus, in contrast to the Examiner, Burakoff, at most, discloses “[t]he logging computer 20, may operate as a sensitive information and consent storing clearinghouse, storing records of consents provided by users a clearinghouse for information and consent storage.” The new claims recite, for example, the limitation “a transaction database for storing at least one transaction record, wherein a transaction record comprises of a plurality of parts wherein each of the plurality of parts contains information related to ownership of the at least one security by an investor.” Burakoff’s “the logging computer 20” is not the “transaction database” of new claims because “records of consents provided by users” of Burakoff’s “logging computer” are not “transaction record[s], wherein [a] transaction record[s] comprise[s] of a plurality of parts wherein each of the plurality of parts contains information related to ownership of the at least one security by an investor.”

Further, the Examiner states that Burakoff, in paragraphs 28 to 30 and 43 to 44, discloses “a processor operatively connected to the network, the processor programmed to receive current investment data for an investor (see paragraph 28-29), identify from the

history source past transaction(s), if any, for the investor (see paragraph 29), identify documents(s) from the at least one investor document applicable to the current investment data received (see paragraph 29-30), determine required investment information for the investor from the identified documents(s) applicable to the transaction and based on the past transactions(s) identified (see paragraph 30 and 43), and retrieve the required investment information from the at least one investor document stored on the electronic document source (see paragraph 30 and 44).” Office Action at 5. In actuality, paragraph 30 of Burakoff discloses:

[0030] The user may be someone who needs sensitive information (such as the potential purchaser of a security) and has a personal computer (individual's computer 16). The other computer 20 may be a server maintained by an entity who distributes sensitive information (such as a clearing house who has a contract with financial institutions to publish security information, or the financial institution itself). If the user gives consent then the entity (on behalf of the financial institution) gives the user access to the sensitive information electronically.

Paragraph 44 of Burakoff discloses:

[0044] After the additional sensitive information becomes available and must be transmitted to the user 14, it will be transmitted from the logging computer 20 to the computer 16 of the user 14. This communication could be, for example, an e-mail transmission with an attachment sent through the communications network 18 along a path conceptually shown as a dotted line 306 through the network 18. Because the user 14 conducts business with the agency or organization and may be unaware of the separate entity of a sender any e-mail transmission sent to the user 14 may be marked as if coming from the agency or organization. Thus, any questions that the user 14 may have relative to the information may be directed to the agency or organization.

Thus, in contrast to the Examiner, Burakoff, at most, discloses transmitting “from the logging computer” to users “the additional sensitive information” as this “sensitive information becomes available,” where users are exemplified by Burakoff as “someone who needs sensitive information (such as the potential purchaser of a security) and has a personal computer (individual's computer 16).” This limitations of Burakoff does not disclose at least the following limitations of new claims:

- “receives a first transaction record from the transaction database with information regarding an ownership of at least one security by the investor;”
- “maps at least one part of the plurality of parts of the first transaction record to at least a first identifier;”
- “determines from past security documents sent to the investor, if any, whether the investor did not previously receive at least a first part of the first security document from the document storage database wherein the first part is associated with the first identifier;”
- “selects, if the investor did not receive the first part, the first part of the first security document;”
- “receives a second transaction record from the transaction database with information regarding an ownership of at least one security by the investor;”
- “maps at least one part of the plurality of parts of the second transaction record to at least a second identifier;”
- “determines from past security documents sent to the investor, if any, whether the investor did not previously receive at least a second part of the second security document from the document storage database wherein the second part is associated with the second identifier;”
- “selects, if the investor did not receive the second part, the second part of the second security document;”
- “combines the selected first part of the first security document and the selected second part of the second security document into an investor document;”

Furthermore, Burakoff '635 does not remedy the deficiencies of Burakoff. As acknowledged by the Examiner, Burakoff '635 determines "the required investment information for the investor by the use of trade identifiers." (Office Action at 5.) Therefore, Burakoff '635 does not disclose, teach, or suggests at least the following limitations of the pending claims:

- "determines from past security documents sent to the investor, if any, whether the investor did not previously receive at least a first part of the first security document from the document storage database wherein the first part is associated with the first identifier;"
- "selects, if the investor did not receive the first part, the first part of the first security document;"
- "determines from past security documents sent to the investor, if any, whether the investor did not previously receive at least a second part of the second security document from the document storage database wherein the second part is associated with the second identifier;"
- "selects, if the investor did not receive the second part, the second part of the second security document."

As explained above, neither Burakoff or Burakoff '635 disclose at least the above described limitations of pending claims. Therefore, the Examiner has not met the burden of showing *prima facie* obviousness to combine Burakoff and Burakoff '635, by a person of ordinary skill in the art at the time of the applicant's invention, to obtain the applicant's invention because of at least:

- 1) both references depends on and require affirmative participation from a user in

the process;

2) Burakoff and Burakoff '635 address completely unrelated goals: Burakoff address the problem of electronic delivery of Burakoff's "sensitive information" based on prior given consent by an user and Burakoff '635 simply automates the process of obtaining of Burakoff '635's "the compliance information" based on an government designation, CUSIP, for a particular security.

In any case, because each of claims 1-35 has been cancelled, it is respectfully submitted that the specific rejections made in the Office Action have been rendered moot.

35 U.S.C §103(a) Rejection based on Burakoff in view of Bosarge

The Examiner has expressly acknowledged that "Burakoff does not explicitly teach wherein the processor is further programmed to retrieve a secondary document, and wherein the consolidation performed by the processor includes consolidation of the secondary document together with the retrieved investment information and wherein the secondary document comprises at least one of the group consisting of a cover page, table of contents, back cover, artwork, advertisement, trade confirmation, or disclaimers." Office Action at 10. Further, as explained above, Burakoff simply discloses a mechanism by which Burakoff's "sensitive information" is delivered to users with electronic addresses on file and who have consented to this electronic delivery. Bosarge does not remedy Burakoff's deficiencies relative to new claims. Bosarge teaches how to add extraneous information to Burakoff's "sensitive information." However, as explained above, Burakoff does not modify or change but only delivers the "sensitive information" to a user who has consented to receiving such information. Even if combined, Burakoff and Bosarge would still lack the following limitations of pending claims:

- “receives a first transaction record from the transaction database with information regarding an ownership of at least one security by the investor;”
- “maps at least one part of the plurality of parts of the first transaction record to at least a first identifier;”
- “determines from past security documents sent to the investor, if any, whether the investor did not previously receive at least a first part of the first security document from the document storage database wherein the first part is associated with the first identifier;”
- “selects, if the investor did not receive the first part, the first part of the first security document;”
- “receives a second transaction record from the transaction database with information regarding an ownership of at least one security by the investor;”
- “maps at least one part of the plurality of parts of the second transaction record to at least a second identifier;”
- “determines from past security documents sent to the investor, if any, whether the investor did not previously receive at least a second part of the second security document from the document storage database wherein the second part is associated with the second identifier;”
- “selects, if the investor did not receive the second part, the second part of the second security document;”
- “combines the selected first part of the first security document and the selected second part of the second security document into an investor document;”

In any case, because each of claims 1-35 has been cancelled, it is respectfully submitted that the specific rejections made in the Office Action have been rendered moot.

35 U.S.C §103(a) Rejection based on Burakoff in view of Burakoff '635 and further in view of TD Canada Trust

As explained above, Burakoff does not teach the applicant's invention. Specifically, Burakoff does not teach at least the step of “ combines the selected first part of the first security document and the selected second part of the second security document into an investor document.” Further, the Examiner has specifically acknowledged that “Burakoff does not explicitly teach wherein the compliance document comprises a simplified prospectus ...”. Office Action at 12.

TD Canada Trust references do not remedy Burakoff's deficiencies with respect to pending claims. TD Canada Trust references represent compilations of the compliance information related to particular mutual fund families, compiled by a security issuer. The combination of Burakoff and TD Canada References simply results in an electronic delivery of this TD Canada References to an user who has given a consent. However, TD Canada Trust references do not disclose, teach or suggest at least the following claim limitation of the applicant's invention:

- “receiving a first transaction record with information regarding an ownership of at least one security by an investor, wherein the first transaction record comprises of a plurality of parts wherein each of the plurality of parts contains information related to ownership of the at least one security by the investor;”
- “determining from past security documents sent to the investor, if any,

whether the investor did not previously receive at least a first part of the at least one security document from the document storage database wherein the first part is associated with the first identifier;”

- “selecting, if the investor did not receive the first part, the first part of the first security document;”
- “receiving a second transaction record with information regarding an ownership of at least one security by the investor, wherein the second transaction record comprises of a plurality of parts wherein each of the plurality of parts contains information related to ownership of the at least one security by the investor;”
- “determining from past security documents sent to the investor, if any, whether the investor did not previously receive at least a second part of the second security document from the document storage database wherein the second part is associated with the second identifier;”
- “selecting, if the investor did not receive the second part, the second part of the second security document;”
- “combining the selected first part of the first security document and the selected second part of the second security document into an investor document.”

In any case, because each of claims 1-35 has been cancelled, it is respectfully submitted that the specific rejections made in the Office Action have been rendered moot.

Conclusion


Accordingly, it is respectfully submitted that the rejections raised by the Examiner in the November 5, 2007 Office Action have been rendered moot and that the above-identified application is now in condition for allowance.

Additionally, it is noted that this Amendment is fully supported by the originally filed application and thus, no new matter has been added. For this reason, the Amendment should be entered. For example, support for each of new claims 36-51 may be found in claims 1-35, as filed, and in the specification.

Favorable reconsideration is earnestly solicited.

Respectfully submitted,
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Dated: May 15, 2008

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